RP9-95-017V

PATENT

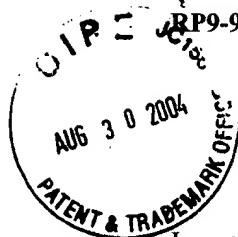## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Bertram et al.
Serial No.: 09/143,967 Art Unit: 2173
Filed: August 31, 1998 Examiner: B. Huynh
For: MOBILE CLIENT COMPUTER PROGRAMMED TO PREDICT INPUT

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION - 37 CFR 1.192)

1. **Transmitted herewith in triplicate is the APPEAL BRIEF in this application with respect to the Notice of Appeal filed on July 28, 2004.**

> *NOTE:* *"The appellant shall, within 2 months from the date of the notice of appeal under § 1.191 in an application, reissue application, or patent under reexamination, or within the time allowed for response to the action appealed from, if such time is later, file a brief in triplicate." 37 CFR 1.192(a) (emphasis added).*

2. **STATUS OF APPLICANT**

    This application is on behalf of

    ☒ other than a small entity

    ☐ small entity

    verified statement:

    ☐ attached

    ☐ already filed

3. **FEE FOR FILING APPEAL BRIEF**

    Pursuant to 37 CFR 1.17(f) the fee for filing the Appeal Brief is:

    ☐ small entity $165.00

    ☒ other than a small entity $330.00

    Appeal Brief fee due $330.00

08/31/2004 ZJUHAR1 00000003 500563 09143967

01 FC:1402 330.00 DA

(Page 1 of 3)

7. FEE DEFICIENCY

NOTE: *If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, 1065 O.G. 31-33.*

☒   If any additional extension and/or fee is required, this is a request therefor and to charge Account No. <u>50-0563</u> <u>(RP9-95-017V)</u>.

AND/OR

☒   If any additional fee for claims is required, charge Account No. <u>50-0563 (RP9-95-017V)</u>.

Reg. No.:   <u>47,159</u>

SIGNATURE OF ATTORNEY OR PATENT AGENT

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Austin_1 258347v.1

4. EXTENSION OF TERM

NOTE: The time periods set forth in 37 CFR 1.192(a) are subject to the provision of § 1.136 for patent applications. 37 CFR 1.191(d). Also see Notice of November 5, 1985 (1060 O.G. 27).

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136 apply.

(complete (a) or (b) as applicable)

(a) ☐ Applicants petition for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

Extension (months)	Fee for other than small entity	Fee for small entity
☐ one month	$ 110.00	$ 55.00
☐ two months	$ 420.00	$ 210.00
☐ three months	$ 950.00	$ 475.00
☐ four months	$ 1,480.00	$ 740.00
Fee		

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

☐ An extension for _____ months has already been secured and the fee paid therefor of $_____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request $_____

or

(b) ☒ Applicants believe that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicants have inadvertently overlooked the need for a petition and fee for extension of time.

5. TOTAL FEE DUE
The total fee due is:
Appeal Brief fee $330.00
Extension fee (if any) $0

TOTAL FEE DUE $330.00

6. FEE PAYMENT
☐ Attached is a check in the sum of $____
☒ Charge Account No. 50-0563 (RP9-95-017V) the sum of $330.00.

A duplicate of this transmittal is attached.

RP9-95-017V   PATENT

- 1 -

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: :   Before the Examiner:
    Bertram et al.   :   Huynh, B.

Serial No.: 09/143,967   :   Group Art Unit: 2173

Filed: August 31, 1998   :
                                     :   IBM Corporation
Title: MOBILE CLIENT COMPUTER   :   P.O. Box 12915
PROGRAMMED TO PREDICT INPUT   :   Dept. 9CCA, Bldg. 002
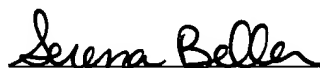   :   Research Triangle Park, NC 27709

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I.   REAL PARTY IN INTEREST

    The real party in interest is International Business Machines Corporation, which is the assignee of the entire right, title and interest in the above-identified patent application.

CERTIFICATION UNDER 37 C.F.R. §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on August 26, 2004.

Serena Beller
Signature

Serena Beller
(Printed name of person certifying)

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, Appellants' legal representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 38, 39, 45, 46, 50, 51, 57, 58, 62, 63, 69, 70 and 73-79 are pending in the Application. Claims 45, 46, 57, 58, 69 and 70 are allowed. Claims 38, 39, 50, 51, 62, 63 and 73-79 stand rejected.

IV. STATUS OF AMENDMENTS

The Appellants' response to the Office Action having a mailing date of December 19, 2003, has been considered, but the Examiner indicated that it did not place the application in condition for allowance because Appellants' arguments were deemed unpersuasive.

V. SUMMARY OF INVENTION

A mobile client system is a system without a wireline connection between a personal computer system and a supporting server. Specification, page 5, lines 3-5. Such systems may require form filling capabilities which may implement "forms widget." See Specification, page 6, lines 1-2. As used herein, a "widget" is a small tool or component of code on a display which accomplishes a specific task. Specification, page 6, lines 5-7. For example, a forms widget may supply a character string for a particular data or information field in a form which is in use. Specification, page 6, lines 7-8. An example might be a forms widget to supply a two letter state identifier for a particular field in a form which requires an address. Specification, page 6, lines 8-10. The forms widget, in this instance, would select

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from among the fifty combinations of two letters adopted by the United States Postal Service to identify the states of the United States. Specification, page 6, lines 10-12. In the example given, the list from which the data is to be supplied is restrained. Specification, page 6, lines 12-13. In other examples, such as a name field for an address form, the list may be essentially unrestrained and must be open to the possibility of additions or manual entry apart from any preselected list. Specification, page 6, lines 13-16.

The mobile client system may be configured to use predictive widgets in a form filling application. Specification, page 6, lines 18-20. A predictive widget is one in which a predictive list is used to provide one or both of a predictive default for entry into a field or a predictive fill for the field. Specification, page 6, lines 20-21. The predictive widget may respond intelligently to use of a form filling application by a user of a system and thus improve user productivity. Specification, page 6, lines 22-23.

In one embodiment, the predictive widget may use frequency and recency to predict the user's choice. Specification, page 19, lines 16-17. Each predictive widget may contain a predictive list, the list of prior or predetermined entries for that widget. Specification, page 19, lines 17-18. The predictive list may contain a record of each entry, so that it can analyze both the frequency and recency of matching entries. Specification, page 19, lines 18-20.

A predictive widget may use its predictive list in two ways. Specification, page 19, line 23. First, the widget may use the list to establish a predictive default. Specification, page 19, lines 23-24. The predictive default may set the initial state of the widget when a form is opened for use. Specification, page 19, lines 24-25. Second, the widget may use the list to establish a predictive fill for the field in question. Specification, page 19, lines 25-26. That is, when a field is selected for filling and a user begins the actions of entering data for the field, the initial few

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characters entered are used to predict the entirety of the data required to fill the field and a suggestion is made for the entire entry. Specification, page 19, line 26 - page 20, line 2.

In one embodiment, both the predictive default and the predictive fill may use frequency, recency or a combination of the two. Specification, page 21, line 27 - page 22, line 2. Predictive defaults and predictive fill may use the same predictive list. Specification, page 22, line 2. However, the two functions may use different balances of frequency and recency. Specification, page 22, lines 2-3. This is illustrated in Figure 10 by the different fulcrum or pointer positions on the "F+R" balance beams. Specification, page 22, lines 3-5.

In one embodiment, predictive fill may display several of the top items in its list. Specification, page 23, line 8. When the user types a letter, predictive fill may complete the field with the most likely value. Specification, page 23, line 8-9. However, it also displays the top five most likely values in a list on the screen. Specification, page 23, line 10. The list is updated with each character the user enters. Specification, page 23, lines 10-11. The user can select any value from the list. Specification, page 23, lines 11-12. Predictive fill may display the list even before the user types anything, while the field still contains the predictive default. Specification, page 23, lines 12-13. An example of this operation is shown in Figure 11, where a predictive fill list is displayed to the left of a keyboard display. Specification, page 23, lines 13-15.

In another embodiment, the presentation of possible data entries in a predictive list may partake of both characteristics of recency and frequency where the entries at the beginning of a sequential list may be assigned for recency determination only. Specification, page 27, lines 12-17. The remainder of the list may have entries assigned positions in the sequence based on frequency only. Specification, page 27, lines 17-18. Thus in displaying the list for a predictive fill or predictive default, the

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first few entries displayed would be based on the most recent entries selected by a user, while entries displayed further down the list would be displayed based on the frequency with which those entries were selected during past use of the application. Specification, page 27, lines 18-22.

VI.   ISSUE

     A.   Are claims 38, 39, 50, 51, 62 and 63 properly rejected under 35 U.S.C. §103(a) as being unpatentable over Capps (U.S. Patent No. 5,666,502) in view of Hoffberg et al. (U.S. Patent No. 5,901,246) (hereinafter "Hoffberg")?

     B.   Are claims 73-79 properly rejected under 35 U.S.C. §103(a) as being unpatentable over Capps in view of Hoffberg and in further view of Miller (U.S. Patent No. 5,805,911)?

VII.   GROUPING OF CLAIMS

Claims 38 ,50 and 62 form a first group.

Claims 39, 51 and 63 form a second group.

Claims 73-79 form a third group.

The reasons for these groupings are set forth in Appellants' arguments in Section VIII.

VIII.   ARGUMENT

     A.   Claims 38, 39, 50, 51, 62 and 63 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Capps in view of Hoffberg.

The Examiner has rejected claims 38, 39, 50, 51, 62 and 63 under 35 U.S.C. §103(a) as being unpatentable over Capps in view of Hoffberg. Paper No. 27, page 2. Appellants respectfully traverse these rejections for at least the reasons stated below.

1.   The Examiner has not presented any objective evidence for combining Capps with Hoffberg.

A *prima facie* showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art reference to make the claimed inventions. M.P.E.P. §2142. The showings must be clear and particular and supported by objective evidence. *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002); *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

The Examiner's motivation for modifying Capps with Hoffberg to supply a predictive default entry for the defined data field where the defined data field is filled with the predictive default entry prior to a user entering a character in the defined data field, as recited in claim 38 and similarly in claims 50 and 62, is "for the improvement wherein acceptable choice can be immediately or quickly presented to the user as suggested by Hoffberg et al. (77:60-63)." Paper No. 27, pages 2-3. The Examiner's motivation is insufficient to support a *prima facie* case of obviousness for at least the reasons stated below.

The Examiner's motivation is not a motivation as to why one of ordinary skill in the art with the primary reference (Capps) in front of him would have been motivated to modify the primary reference (Capps) with the teachings of the secondary reference (Hoffberg). There is no suggestion in Capps of supplying a predictive default entry for the defined data field in order to present an immediate or quickly present an acceptable choice to the user (Examiner's motivation).   The Examiner's motivation is a motivation for the secondary reference (Hoffberg) to solve

its problem. Hoffberg teaches that the problem to be solved is to reduce the time necessary to communicate a desired action through an interface to a computerized device. Column 26, lines 28-34. Hoffberg solves this problem by seeking to reduce the time necessary to communicate a desired action through an interface to a computerized device by predicting a most likely input from the operator and present this as an easily available option. Column 26, lines 35-38. Hence, the Examiner's motivation addresses the problem to be solved in Hoffberg. The Examiner's motivation is not a suggestion to combine the primary reference (Capps) with the secondary reference (Hoffberg). The Examiner must provide objective evidence as to why one of ordinary skill in the art with the primary reference (Capps) in front of him, which teaches a data input technique for a computer that provides the user with a historical list of potential choices for the data input (Abstract of Capps), would have been motivated to modify the teachings of the primary reference (Capps) with the teachings of the secondary reference (Hoffberg), which teaches the use of an intelligent, adaptive pattern recognition in order to provide the operator with a small number of high probability choices without the need for explicit definition of each atomic instruction comprising the desired action (Column 26, lines 41-49). *See In re Lee*, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002); *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000). Merely stating the motivation to solve the problem of the secondary reference (Hoffberg) is not evidence for suggesting the combination of the primary reference (Capps) with the secondary reference (Hoffberg). *See Id*. Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 38, 39, 50, 51, 62 and 63. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of combining Capps, which teaches a data input technique for a computer that provides the user with a historical list of potential choices for the data input, with Hoffberg, which teaches the use of an intelligent,

adaptive pattern recognition in order to provide the operator with a small number of high probability choices without the need for explicit definition of each atomic instruction comprising the desired action. *Id.* There is no suggestion in Capps of using pattern recognition. Neither is there any suggestion in Capps of using an intelligent, adaptive pattern recognition. Neither is there any suggestion in Capps of using an intelligent, adaptive pattern recognition in order to provide the operator with a small number of high probability choices. Neither is there any suggestion in Capps of using an intelligent, adaptive pattern recognition in order to provide the operator with a small number of high probability choices without the need for explicit definition of each atomic instruction comprising the desired action. Since the Examiner has not submitted objective evidence for modifying Capps with Hoffberg, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 38, 39, 50, 51, 62 and 63. *Id.*

Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Capps to supply a predictive default entry for the defined data field where the defined data field is filled with the predictive default entry prior to a user entering a character in the defined data field (Examiner admits that Capps does not teach this limitation). *Id.* There is no suggestion in Capps of supplying a predictive default entry. Neither is there any suggestion in Capps of supplying a predictive default entry for a defined data field. Neither is there any suggestion in Capps of supplying a predictive default entry for a defined data field where the defined data field is filled with the predictive default entry prior to a user entering a character in the defined data field. Since the Examiner has not submitted objective evidence for modifying Capps to supply a predictive default entry for the defined data field, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 38, 39, 50, 51, 62 and 63. *Id.*

As a result of the foregoing, Appellants respectfully assert that the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 38, 39, 50, 51, 62 and 63. M.P.E.P. §2143.

        2.   By combining Capps with Hoffberg, the principle of operation Capps would change.

If the proposed modification or combination of the prior art would change the principle of the operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959). Further, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). For the reasons discussed below, Appellants submit that by combining Capps with Hoffberg, the principle of operation in Capps would change and subsequently render the operation of Capps to perform its purpose unsatisfactorily.

Capps teaches that the present invention <u>relates generally to computer systems and more particularly to data input techniques for computer systems</u>. Column 1, lines 5-7. Capps further teaches that computer systems require user input for one reason or another. Column 1, lines 63-64. Capps further teaches that the typical input sources are a keyboard, a mouse and a track ball, and in case of pen-based computers, a stylus. Column 1, lines 64-66. Capps further teaches that a historical list is displayed to the user so that the user can input data by selecting an item from the historical list being displayed. Column 2, lines 20-23.

Hoffberg, on the other hand, teaches an adaptive interface for a programmable system, for predicting a desired user function, based on user history, as well as a machine internal status and context. Abstract. Hoffberg further teaches that applications of the interface and system include a <u>VCR, medical device, vehicle</u>

control system, audio device, environmental control system, securities trading terminal, and a smart house. Abstract.

Hence, by combining Capps with Hoffberg, Capps would no longer be able to display a historical list to a user of a computer system so that the user can input data by selecting an item from the historical list being displayed on the computer system. Instead, Capps would have to be modified to be either a VCR, a medical device, a vehicle control system, an audio device, an environmental control system, a securities trading terminal, or a smart house, as taught by Hoffberg. Hence, Capps would no longer be able to display a historical list to a user of a computer system. Consequently, by combining Capps with Hoffberg, the principle of operation in Capps would change and subsequently render the operation of Capps to perform its purpose unsatisfactorily. Therefore, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 38, 39, 50, 51, 62 and 63. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

                 3.   The Examiner has not presented a reasonable expectation of success when combining Capps with Hoffberg.

The Examiner must present a reasonable expectation of success in combining Capps with Hoffberg in order to establish a *prima facie* case of obviousness. M.P.E.P. §2143.02. As stated above, Capps teaches displaying a historical list to a user of a computer system. Hoffberg, on the other hand, teaches a VCR, a medical device, a vehicle control system, an audio device, an environmental control system, a securities trading terminal, and a smart house with the capability of predicting a desired user function. The Examiner has not presented any evidence that there would be a reasonable expectation of success in combining Capps, which teaches displaying a historical list to a user of a computer system, with Hoffberg, which teaches a VCR, a medical device, a vehicle control system, an audio device, an environmental control system, a securities trading terminal, and a smart house with the capability of

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predicting a desired user function. The Examiner has not provided any evidence as to how displaying a historical list to a user of a computer system would be combined with a VCR, a medical device, a vehicle control system, an audio device, an environmental control system, a securities trading terminal, or a smart house. Consequently, the Examiner has not provided a *prima facie* case of obviousness for rejecting claims 38, 39, 50, 51, 62 and 63. M.P.E.P. §2143.02.

> 4.   Capps and Hoffberg, taken singly or in combination, do not teach or suggest the following claim limitations.

Appellants respectfully assert that Capps and Hoffberg, taken singly or in combination, do not teach or suggest "exercising the predictive widget to supply a predictive default entry for the defined data field, wherein the defined data field is filled with the predictive default entry prior to a user entering a character in the defined data field" as recited in claim 38 and similarly in claims 50 and 62. The Examiner cites column 51, lines 62-66; column 77, lines 55-63 and column 81, lines 10-21 of Hoffberg as teaching the above-cited claim limitation. Paper No. 27, page 2. Appellants respectfully traverse and assert that Hoffberg instead teaches displaying the most frequently used choices as the default setting. Column 51, lines 62-63. Hoffberg further teaches that a most probable choice may be presented to the user for his approval or another alternative choice may be selected. Column 77, lines 58-59. Hoffberg further teaches that the system could display the broadcast schedule of the channel for the selected day if the user had input the channel or network. Column 81, lines 17-21. None of this language teaches presenting the most probable choice in a defined data field. Further, there is no language in the cited passages of Hoffberg that teaches presenting the most probable choice in a defined data field where the defined data field is filled with the predictive default entry prior to a user entering a character in the defined data field.

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Neither does Capps teach or suggest supplying a predictive default entry for a defined data field. Instead, Capps teaches supplying a historical list to the user for a field in a form. Column 9, line 65 - column 10, line 32.

Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Appellants further assert that Capps and Hoffberg, taken singly or in combination, do not teach or suggest "wherein the control program and the processor cooperate, when the control program is executing on the processor, in storing a predictive list and selecting a predictive default entry from the predictive list based on a predetermined algorithm, wherein the defined data field is filled with the predictive default entry prior to a user entering a character in the defined data field" as recited in claim 39 and similarly in claims 51 and 63. The Examiner cites column 51, lines 62-66; column 77, lines 55-63 and column 81, lines 10-21 of Hoffberg as teaching the above-cited claim limitation. Paper No. 27, page 2. Appellants respectfully traverse and assert that Hoffberg instead teaches displaying the most frequently used choices as the default setting. Column 51, lines 62-63. Hoffberg further teaches that a most probable choice may be presented to the user for his approval or another alternative choice may be selected. Column 77, lines 58-59. Hoffberg further teaches that the system could display the broadcast schedule of the channel for the selected day if the user had input the channel or network. Column 81, lines 17-21. There is no language in the cited passages that teaches selecting the most probable choice from a predictive list based on a predetermined algorithm. Further, there is no language in the cited passages that teaches filling a defined data field. Further, there is no language in the cited passages that teaches filling a defined data field with the predictive default entry prior to a user entering a character in the defined data field.

Neither does Capps teach or suggest a program for selecting a predictive default entry from the predictive list based on a predetermined algorithm. Neither does Capps teach or suggest a program for filling a defined data field with the predictive default entry prior to a user entering a character in the defined data field. Instead, Capps teaches supplying a historical list to the user for a field in a form. Column 9, line 65 - column 10, line 32. However, Capps does not teach a program for selecting an entry from the historical list based on a predetermined algorithm that is used to fill a data field.

Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

As a result of the foregoing, Appellants respectfully assert that there are numerous claim limitations not taught or suggested in the cited prior art, and thus the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 38, 39, 50, 51, 62 and 63 as being unpatentable over Capps in view of Hoffberg. M.P.E.P. §2143.

B.   Claims 73-79 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Capps in view of Hoffberg and in further view of Miller.

The Examiner has rejected claims 73-79 under 35 U.S.C. §103(a) as being unpatentable over Capps in view of Hoffberg and in further view of Miller. Paper No. 27, page 3. Appellants respectfully traverse these rejections for at least the reasons stated below.

1.   The Examiner has not presented any objective evidence for combining Capps with Hoffberg and Miller.

As stated above, a *prima facie* showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in

combination, all of the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art reference to make the claimed inventions. M.P.E.P. §2142. The showings must be clear and particular and supported by objective evidence. *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002); *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 U.S.P.Q.2d. 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

The Examiner's motivation for modifying Capps with Hoffberg and Miller for predicatively filling an entry in a form after the user enters one or more characters in an entry, as recited in claim 73 is "for the advantage of having the capability to predict user desirable option from the first few characters inputted by the user." Paper No. 27, page 4. The Examiner's motivation is insufficient to support a *prima facie* case of obviousness for at least the reasons stated below.

The Examiner's motivation is insufficient to support a *prima facie* case of obviousness, since it is merely the Examiner's subjective opinion and appears to be based on hindsight rather than the teachings of the references. In fact, the Examiner's motivation is a restatement of the above-cited claim limitation. The Examiner's conclusion of obviousness cannot be based on improper hindsight reasoning. *In re McLaughlin*, 170 U.S.P.Q. 209, 212 (C.C.P.A. 1971); M.P.E.P. §2145. The Examiner must provide objective evidence from the references themselves or from evidence of the level of skill in the art at the time of the invention that would suggest a motivation to combine these references. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002); *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). Consequently, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 73-79. M.P.E.P. §2143.

Furthermore, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of combining Capps, which teaches a data input technique for a computer that provides the user with a historical list of potential choices for the data input, with Miller, which teaches providing and selecting multiple text predictions from text entered from multiple windows of a computer system using an application independent text prediction system (Abstract of Miller). *Id.* There is no suggestion in Capps of providing multiple text predictions from text entered from multiple windows of a computer system. Neither is there any suggestion in Capps of selecting multiple text predictions from text entered from multiple windows of a computer system. Neither is there any suggestion in Capps of using an application independent text prediction system. Neither is there any suggestion in Capps of providing and selecting multiple text predictions from text entered from multiple windows of a computer system using an application independent text prediction system. Since the Examiner has not submitted objective evidence for modifying Capps with Miller, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 73-79. *Id.*

Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Capps to predicatively fill an entry in a form after the user enters one or more characters in an entry (Examiner admits that Capps does not teach this limitation). *Id.* There is no suggestion in Capps of predicatively filling an entry in a form. Neither is there any suggestion in Capps of predicatively filling an entry in a form after the user enters one or more characters in an entry. Since the Examiner has not submitted objective evidence for modifying Capps to predicatively fill an entry in a form after the user enters one or more characters in an entry, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 73-79. *Id.*

As a result of the foregoing, Appellants respectfully assert that the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 73-79. M.P.E.P. §2143.

> 2. Capps, Hoffberg and Miller, taken singly or in combination, do not teach or suggest the following claim limitations.

Appellants respectfully assert that Capps, Hoffberg and Miller, taken singly or in combination, do not teach or suggest "circuitry operable for predicting a default user's choice in an entry in said form prior to said user enters a character in said entry" as recited in claim 73. The Examiner cites column 51, lines 62-66; column 77, lines 55-63 and column 81, lines 10-21 of Hoffberg as teaching the above-cited claim limitation. Paper No. 27, page 3. Appellants respectfully traverse and assert that Hoffberg instead teaches displaying the most frequently used choices as the default setting. Column 51, lines 62-63. Hoffberg further teaches that a most probable choice may be presented to the user for his approval or another alternative choice may be selected. Column 77, lines 58-59. Hoffberg further teaches that the system could display the broadcast schedule of the channel for the selected day if the user had input the channel or network. Column 81, lines 17-21. None of this language teaches presenting the most probable choice in <u>an entry in a form</u>. Further, there is no language in the cited passages of Hoffberg that teaches predicting a default user's choice in an entry in a form prior to a user entering a character in the entry.

Neither does Capps teach or suggest predicting a default user's choice in an entry in a form prior to the user entering a character in the entry. Instead, Capps teaches supplying a historical list to the user for a field in a form. Column 9, line 65 - column 10, line 32.

Neither does Miller teach or suggest predicting a default user's choice in an entry in a form prior to the user entering a character in the entry.

Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

As a result of the foregoing, Appellants respectfully assert that there are numerous claim limitations not taught or suggested in the cited prior art, and thus the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 73-79 as being unpatentable over Capps in view of Hoffberg and in further view of Miller. M.P.E.P. §2143.

IX.   CONCLUSION

For the reasons noted above, the rejections of claims 38, 39, 50, 51, 62, 63 and 73-79 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 38, 39, 45, 46, 50, 51, 57, 58, 62, 63, 69, 70 and 73-79.

Respectfully submitted,

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APPENDIX

38.   A mobile client computer comprising:

a housing sized to be held and manipulated by the hand of a user;

a processor mounted within the housing for processing digital data;

memory mounted within the housing for storing digital data and coupled to the processor; a display mounted in the housing and coupled to the processor and the memory for displaying information derived from digital data processed by the processor;

an input digitizer mounted in the housing and overlaying the display, the digitizer being coupled to the processor for input of digital data by a user; and

a control program stored in the memory and accessible by the processor for directing the processing of digital data by the processor;

the control program and the processor cooperating, when the control program is executing on the processor, in

a)   displaying a form defining data fields; and

b)   exercising a predictive widget to supply a data entry for a defined data field;

wherein the control program and the processor cooperate, when the control program is executing on the processor, in exercising the predictive widget to supply a predictive default entry for the defined data field, wherein the defined data field is filled with the predictive default entry prior to a user entering a character in the defined data field.

39.   A mobile client computer comprising:

a housing sized to be held and manipulated by the hand of a user;

a processor mounted within the housing for processing digital data;

memory mounted within the housing for storing digital data and coupled to the processor; a display mounted in the housing and coupled to the processor and the memory for displaying information derived from digital data processed by the processor;

an input digitizer mounted in the housing and overlaying the display, the digitizer being coupled to the processor for input of digital data by a user; and

a control program stored in the memory and accessible by the processor for directing the processing of digital data by the processor;

the control program and the processor cooperating, when the control program is executing on the processor, in

    a)   displaying a form defining data fields; and

    b)   exercising a predictive widget to supply a data entry for a defined data field;

wherein the control program and the processor cooperate, when the control program is executing on the processor, in storing a predictive list and selecting a predictive default entry from the predictive list based on a predetermined algorithm, wherein the defined data field is filled with the predictive default entry prior to a user entering a character in the defined data field.

45.   A mobile client computer comprising:

a housing sized to be held and manipulated by the hand of a user;

a processor mounted within the housing for processing digital data;

memory mounted within the housing for storing digital data and coupled to the processor; a display mounted in the housing and coupled to the processor and the memory for displaying information derived from digital data processed by the processor;

an input digitizer mounted in the housing and overlaying the display, the digitizer being coupled to the processor for input of digital data by a user; and

a control program stored in the memory and accessible by the processor for directing the processing of digital data by the processor;

the control program and the processor cooperating, when the control program is executing on the processor, in

    a)   displaying a form defining data fields; and

    b)   exercising a predictive widget to supply a data entry for a defined data field;

wherein the control program and the processor cooperate, when the control program is executing on the processor, in storing a predictive list and selecting a data entry from the predictive list based on a predetermined algorithm;

wherein the control program and the processor cooperate, when the control program is executing on the processor, in selecting a data entry from the predictive list based upon a user selected weighted determination of the recency and frequency of use of listed data entries.

46.   A mobile client computer comprising:

    a housing sized to be held and manipulated by the hand of a user;

    a processor mounted within the housing for processing digital data;

memory mounted within the housing for storing digital data and coupled to the processor; a display mounted in the housing and coupled to the processor and the memory for displaying information derived from digital data processed by the processor;

an input digitizer mounted in the housing and overlaying the display, the digitizer being coupled to the processor for input of digital data by a user; and

a control program stored in the memory and accessible by the processor for directing the processing of digital data by the processor;

the control program and the processor cooperating, when the control program is executing on the processor, in

    a)   displaying a form defining data fields; and

b)   exercising a predictive widget to supply a data entry for a defined data field;

wherein the control program and the processor cooperate, when the control program is executing on the processor, in storing a predictive list and selecting a data entry from the predictive list based on a predetermined algorithm;

wherein the control program and the processor cooperate, when the control program is executing on the processor, in storing the predictive list as a sequence of possible data entries and in ordering the sequence by positioning a leading portion of the sequence based on the recency of use of listed data entries and a trailing portion of the sequence based on the frequency of use of listed data entries.

50.   A computer comprising:

a housing;

a processor mounted within the housing and processing digital data;

memory mounted within the housing for storing digital data and coupled to the processor;

a display coupled to the processor and the memory to display information derived from digital data processed by the processor; and

a control program stored in the memory and accessible by the processor to direct the processing of digital data by the processor;

the control program and the processor cooperating, when the control program is executing on the processor, in

a)   displaying a form defining data fields; and

b)   exercising a predictive widget to supply a data entry for a defined data field;

wherein the control program and the processor cooperate, when the control program is executing on the processor, in exercising the predictive widget to supply a predictive default entry for the defined data field, wherein the defined data field is

filled with the predictive default entry prior to a user entering a character in the defined data field.

51.   The computer according to Claim 50, wherein the control program and the processor cooperate, when the control program is executing on the processor, in storing a predictive list and selecting a predictive default entry from the predictive list based on a predetermined algorithm.

57.   A computer comprising:

a housing;

a processor mounted within the housing and processing digital data;

memory mounted within the housing for storing digital data and coupled to the processor;

a display coupled to the processor and the memory to display information derived from digital data processed by the processor; and

a control program stored in the memory and accessible by the processor to direct the processing of digital data by the processor;

the control program and the processor cooperating, when the control program is executing on the processor, in

a)   displaying a form defining data fields; and

b)   exercising a predictive widget to supply a data entry for a defined data field;

wherein the control program and the processor cooperate, when the control program is executing on the processor, in a storing predictive list and selecting a data entry from the predictive list based on a predetermined algorithm;

wherein the control program and the processor cooperate, when the control program is executing on the processor, in selecting a data entry from the predictive list based upon a user selected weighted determination of the recency and frequency of use of listed data entries.

58.   A computer comprising:

a housing;

a processor mounted within the housing and processing digital data;

memory mounted within the housing for storing digital data and coupled to the processor;

a display coupled to the processor and the memory to display information derived from digital data processed by the processor; and

a control program stored in the memory and accessible by the processor to direct the processing of digital data by the processor;

the control program and the processor cooperating, when the control program is executing on the processor, in

a)   displaying a form defining data fields; and

b)   exercising a predictive widget to supply a data entry for a defined data field;

wherein the control program and the processor cooperate, when the control program is executing on the processor, in a storing predictive list and selecting a data entry from the predictive list based on a predetermined algorithm;

wherein the control program and the processor cooperate, when the control program is executing on the processor, in storing the predictive list as a sequence of possible data entries and in ordering the sequence by positioning a leading portion of the sequence based on the recency of use of listed data entries and a trailing portion of the sequence based on the frequency of use of listed data entries.

62.   A display generating system comprising:

a housing;

a processor mounted within the housing and processing digital data;

memory mounted within the housing for storing digital data and coupled to the processor;

the processor and the memory cooperating in supplying digital data driving a display of visual images; and

a control program stored in the memory and accessible by the processor to direct the processing of digital data by the processor;

the control program and the processor cooperating, when the control program is executing on the processor, in

a)   displaying a form defining data fields; and

b)   exercising a predictive widget to supply a data entry for a defined data field;

wherein the control program and the processor cooperate, when the control program is executing on the processor, in exercising the predictive widget to supply a predictive default entry for the defined data field, wherein the defined data field is filled with the predictive default entry prior to a user entering a character in the defined data field.

63.   The system according to Claim 62, wherein the control program and the processor cooperate, when the control program is executing on the processor, in storing a predictive list and selecting a predictive default entry from the predictive list based on a predetermined algorithm.

69.   A display generating system comprising:

a housing;

a processor mounted within the housing and processing digital data;

memory mounted within the housing for storing digital data and coupled to the processor;

the processor and the memory cooperating in supplying digital data driving a display of visual images; and

a control program stored in the memory and accessible by the processor to direct the processing of digital data by the processor;

the control program and the processor cooperating, when the control program is executing on the processor, in

a) displaying a form defining data fields; and

b) exercising a predictive widget to supply a data entry for a defined data field;

wherein the control program and the processor cooperate, when the control program is executing on the processor, in storing a predictive list and selecting a data entry from the predictive list based on a predetermined algorithm;

wherein the control program and the processor cooperate, when the control program is executing on the processor, in selecting a data entry from the predictive list based upon a user selected weighted determination of the recency and frequency of use of listed data entries.

70. A display generating system comprising:

a housing;

a processor mounted within the housing and processing digital data;

memory mounted within the housing for storing digital data and coupled to the processor;

the processor and the memory cooperating in supplying digital data driving a display of visual images; and

a control program stored in the memory and accessible by the processor to direct the processing of digital data by the processor;

the control program and the processor cooperating, when the control program is executing on the processor, in

a) displaying a form defining data fields; and

b) exercising a predictive widget to supply a data entry for a defined data field;

wherein the control program and the processor cooperate, when the control program is executing on the processor, in storing a predictive list and selecting a data entry from the predictive list based on a predetermined algorithm;

wherein the control program and the processor cooperate, when the control program is executing on the processor, in storing the predictive list as a sequence of possible data entries and in ordering the sequence by positioning a leading portion of the sequence based on the recency of use of listed data entries and a trailing portion of the sequence based on the frequency of use of listed data entries.

73.   A system, comprising:

a memory unit operable for storing a computer program operable for predicting a user's choice in one or more entries in a form;

a processor coupled to said memory unit, wherein said processor, responsive to said computer program, comprises:

circuitry operable for predicting a default user's choice in an entry in said form prior to said user enters a character in said entry; and

circuitry operable for predictively filling an entry in said form after said user enters one or more characters in said entry.

74.   The system as recited in claim 73, wherein said predicting said default user's choice is based on one of a recency and a frequency of data entries previously entered by said user in one or more entries in said form.

75.   The system as recited in claim 73, wherein said predicting said default user's choice is based on a combination of a recency and a frequency of data entries previously entered by said user in one or more entries in said form.

76.   The system as recited in claim 73, wherein said predictively filling said entry in said form after said user enters one or more characters in said entry is based on a

combination of a recency and a frequency of data entries previously entered by said user in one or more entries in said form.

77.   The system as recited in claim 73, wherein said processor further comprises:

circuitry operable for presenting to said user a list of data entries most likely to be selected by said user to fill an entry in said form, wherein said list of data entries comprises data entries previously entered by said user in one or more entries in said form.

78.   The system as recited in claim 77, wherein said list of data entries is organized by one of a recency and a frequency of data entries previously entered by said user in one or more entries in said form.

79.   The system as recited in claim 77, wherein said list of data entries is organized by a combination of a recency and a frequency of data entries previously entered by said user in one or more entries in said form.

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